

The statement of the rejection suggests that the standard for issuance of an obviousness-type double patenting rejection is a mere overlap in subject matter. This is not the case. The standard requires consideration of whether the later-filed claims would have been **obvious**, and this is applied in much the same way as an analysis under 35 USC § 103. It is clear that species can be patented, even after the patenting of a genus which encompasses the species. Where, as here, the species is unobvious, no double-patenting rejection is proper.

Moreover, it is noted that US Patent No. 5,387,508 is being considered as a reference for its complete teachings and has been applied by the Examiner in his art rejection. This being the case, if this rejection is overcome, then the claims are plainly not obvious over the rejection. Thus, the double-patenting rejection is cumulative with the art rejection and therefore unnecessary. For this reason, no terminal disclaimer is filed.

On the merits, the Examiner rejected claims 1-15 under 35 USC § 103 as obvious over US Patent No. 5,387,508. It has been the Examiner's position that this application disclosed a whole effluent test for *T. rostratus*, and that the use of other flagellates would have been obvious. Applicants respectfully traverse this rejection.

In the Office Action, the Examiner for the first time explained the basis for his assertion that the '508 patent discloses a WET test. Specifically, he argues that the collection of fumes in Example 5 is a whole effluent test is a WET test because no concentration or dilution is recited. Applicants respectfully submit that this test would not be understood by a person skilled in the art as a WET test. The fumes are captured by passing air through a liquid medium, which is then added to the flagellate culture. This is consistent with the rest of the disclosure of the '508 patent. Such capture would not realistically capture all potentially toxic components in the air equally and thus would not be considered a "whole effluent sample." Furthermore, the "concentration" depends on many factors including the capture efficiency of the liquid medium, the volume of the liquid medium, and the amount of air passed through the liquid medium. Thus, the assertion that there is no change in concentration is not well founded. Nevertheless, to make the distinction between this test and the WET test of the present claims, claim 1 has been

amended to recite a **liquid** whole effluent sample. There is nothing in the '508 patent which suggests that such a test could be performed using the *T. rostratus* assay.

It is noted that these amendments to claim 1 are necessitated by arguments and explanations set forth for the first time in the Office Action of February 18, 2000. Thus, even if the finality is maintained, entry of these amendments is appropriate because Applicant could not have made them sooner.

The Examiner has also asserted that the step of collecting the sample is not limited to any specific type of sample. Applicant respectfully disagrees. The claim recites obtaining a liquid **whole effluent** sample. As this term is used in the art and in the specification, the words **whole effluent** have meaning which cannot be ignored, and which does not include prior concentration steps of the type performed in the examples of the '508 patent. Rather, it is a test intended to look at aggregate toxicity. Thus, the Examiner's argument that there are no limitations as to the nature of the sample are not well-founded.

With respect to claims reciting specific flagellates other than *T. rostratus*, the Examiner has continued to rely on **this specification** for evidence of the obviousness of these species. No reasons are offered why a person skilled in the art, reading the teachings of the '508 patent would believe that other flagellates would work. Applicants do not have to show unexpected results or advantages to render unobvious something which is not even hinted at in the art. Thus, it is plain that the Examiner has failed to present a *prima facie* case of obviousness with respect to these claims.

Finally, with respect to claims 7 and 11 Applicant is not masking the invention. The Examiner has apparently overlooked the fact that the steps recited in these claims are **additional** steps. They do not alter the basic assay procedure, but add a parallel assay which allows additional information to be provided about the whole effluent sample. Nothing in the art teaches or suggests such a parallel assay system, and the Examiner has offered no evidence or arguments as to why a person skilled in the art would find them obvious.

For the foregoing reasons, Applicant submits that this application is now in form for allowance. Favorable reconsideration and allowance of all claims are respectfully urged.

Respectfully submitted,



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